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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/233,475 | 01/20/1999 | KUNIHICO WAKABAYASHI | 017344-0290 | 7383 |

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EXAMINER

CHOW, MING

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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2645

DATE MAILED: 02/23/2004

21

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/233,475

Applicant(s)

WAKABAYASHI, KUNIIHIKO

Examiner

Ming Chow

Art Unit

2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,11,12 and 17-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,11,12 and 17-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. Claims 1, 2, 11, 12 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The phrase “the sender number corresponds to a telephone set of the sender” of claims 1, 2, 11, 12 are not disclosed by the specification. The specification, on lines 7, 9-10, 21 of page 2 states “a proper number of a sender”. The specification did not support that the limitation “sender number corresponds to a telephone set of the sender”. In particular, the Examiner has provided evidences that the sender number does not have to be a number corresponds to the

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caller's telephone set (telephone number; see Brown et al). A sender number can be a calling card number to be used for storing the voice message in a particular memory address.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 2, 11, 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cooper et al (US: 6052442), and in view of Inoue (JP 405227274A) and Brown et al (US: 4972461).

For claims 1, 2, 11 and 12, regarding "a memory.....from a sender", Cooper et al teach on column 4 line 39 "incoming voice messages are digitized by A/D converter and stored in memory".

Cooper et al failed to teach "the memory further.....the voice mail". However, Inoue teaches on Abstract – an answering machine with a storage means (claimed "memory") for recording both incoming and reply messages.

Regarding an identifier to identify a sender number attached to the voice mail that contains the digitized voice, the sender number corresponding to the sender that has sent the

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digitized voice, Cooper et al teach on column 2 line 59 “when the answering machine answers a call, before playing an outgoing message, it may read the telephone number of the calling party using the Calling Number Delivery (CND) service”. It is inherent that there must be an identifier of Cooper’s system to identify the sender number.

Regarding “an e-mail transmitter.....to the sender”, Cooper et al teach on column 7 line 47-51 a processor (claimed “e-mail transmitter”) packages the reply into the email format and transmits it to the sender of the original message.

Regarding a table that provides a correspondence between a plurality of e-mail addresses and a plurality of sender numbers, respectively; and a control unit.....apparatus, wherein the table is accessed to allow a recipient of the digitized voice to send an e-mail response to the corresponding e-mail address of the sender, Cooper et al teach on item 10 Fig. 1 “processor” (claimed “control unit”). Cooper et al teach on column 9 line 40 “memory may include a pre-stored correspondence or ‘telephone directory’ between telephone numbers and.....other identifying information.....the user may also choose to automatically store email addresses of some or all senders into the telephone directory”. The “telephone directory” of Cooper et al is the claimed “table”. The “between telephone numbers and.....other identifying information.....the user may also choose to automatically store email addresses of some or all senders” reads on the claimed “correspondence between a plurality of e-mail addresses and a plurality of sender numbers”. Cooper et al also teach on column 11 line 26 “the user may select the destination address by using keypad to choose an entry in the telephone directory stored in memory”. The “using keypad to choose an entry in the telephone directory” of Cooper et al is the claimed “the table is accessed to allow a recipient....”. Cooper et al also teach on column 7 line 44 “the user

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may compose text for the reply using keypad”. The “text for the reply” of Cooper et al reads on the claimed “send an e-mail response”.

Cooper et al failed to teach “the digitized voice.....by the identifier”. However, Brown et al teach on column 5 line 13-14 recording digitized voice messages. Brown et al also teach on column 16 line 33-34 recording caller’s voice message at a memory location identifiable using said caller’s billing code (claimed “ based on the identification of the sender number”).

Regarding “the control unit obtains.....to the sender”, Cooper et al teach on column 7 line 47-51 a processor (claimed “control unit”) packages the reply into the email format and transmits it to the sender of the original message.

Regarding “the e-mail.....response message”, “Official Notice” is taken that opening an email and reviewing its attached voice response is old and well known to one skilled in the art. Also, although, Cooper et al did not teach how the original message sender opens an email and reviews its voice response attachment but Cooper et al did teach how the original message recipient opens an email and reviews its voice attachment (see column 2 line 1-7).

It would have been obvious to one skilled at the time the invention was made to modify Cooper et al to have the “the memory further.....the voice mail” and “the e-mail.....response message” as taught by Inoue, “the digitized voice.....by the identifier” as taught by Brown et al such that the modified system of Cooper et al would be able to support the memory, and opening the mail with an voice response attachment, and the memory address to the system users.

3. Claims 17-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cooper et al and Inoue, Brown et al as stated in claim 1 above, and in view of Goldberg et al (US: 6304636).

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Regarding claims 17, 19, 21, 23, Cooper et al and Inoue failed to teach “the at least.....to the sender”. However, Goldberg et al teach on column 3 line 26-28 the voice message is converted to be digitized text and included within the e-mail. It would have been obvious to one skilled at the time the invention was made to modify Cooper et al and Inoue to have the “the at least.....to the sender” as taught by Goldberg et al such that the modified system of Cooper et al and Inoue would be able to support the converting voice messages to be text to the system users.

Regarding claims 18, 20, 22, 24, Cooper et al and Inoue failed to teach “the sender.....a text file”. However, Goldberg et al teach on column 3 line 32-34 the voice message within the email can be either listened to if it’s an audio file or can be read if it’s in a text format. It would have been obvious to one skilled at the time the invention was made to modify Cooper et al and Inoue to have the “the sender.....a text file” as taught by Goldberg et al such that the modified system of Cooper et al and Inoue would be able to support the listening or reading the audio message to the system users.

Response to Arguments

4. Applicant's arguments filed on 10/14/03 have been fully considered but they are not persuasive.

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- i) Applicant states, on page 7, regarding the approval of the formal drawing. The formal drawing (paper no. 18) is approved and the approval has been indicated on PTOL-326.
- ii) Applicant argues, on page, regarding “a voice message from a caller is stored at a called party’s device in accordance with a sender number of a sender’s telephone set”. First, the “a voice message from a caller is stored at a called party’s device” is not a limitation claimed in the claims. Further, see USC 112 first paragraph rejection stated above, the argued limitation is not supported by the specification.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5. Any inquiry concerning this application and office action should be directed to the examiner Ming Chow whose telephone number is (703) 305-4817. The examiner can normally be reached on Monday through Friday from 8:30 am to 5 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang, can be reached on (703) 305-4895. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Customer Service whose telephone number is (703) 306-0377. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

Or faxed to TC2600's Customer Service FAX Number 703-872-9314.

Patent Examiner

Art Unit 2645

Ming Chow



FAN TSANG
SUPERVISOR, PATENT EXAMINER
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